



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,208	06/26/2003	Barton D. Gaskins	067949-5025	4366
9629	7590	09/20/2007		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER PRIDDY, MICHAEL B	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No. **10/606,208**Applicant(s) **GASKINS ET AL.**

Examiner

Michael B. Priddy

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-86 and 94-110 is/are pending in the application.
- 4a) Of the above claim(s) 94-97, 111/94, 111/95, 111/96 and 111/97 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33-46 and 98-110 is/are allowed.
- 6) ☒ Claim(s) 47-49, 64-74, 77 and 111/47 is/are rejected.
- 7) ☒ Claim(s) 50-63 and 78-86 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species A of Fig. 9 (claims 33-86 and 98-111) in the reply filed on 06/18/2007 is acknowledged. Claims 94-97 are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 47-49, 64-68, 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Zirkiev (US Pat 5745999).

Zirkiev discloses a device with a base (14) with a cutter (18) which is movable, a substrate chute (hole through the base), tower (40) coupled to the base with a lower surface (34), a recess (the hollow of 12) that is in alignment with the substrate chute, and a clamping mechanism (30) which keeps the substrate in contact with the cutter. (figure 1, 2; claim 47) Zirkiev has a device with a receptacle (12) under the cutter and the clamping mechanism has a series of pins and projections (75, 76, figure 3) that make the "grooves on the contact surface" of the clamping mechanism (col4:55-61) (claim 48-49). Zirkiev discloses a device with the cutter having a leading edge (where 20 is pointing to) and a trailing edge (42) where the trailing edge is set at a height above the

Art Unit: 3733

leading edge, a blade section (26) and a substrate fiber channel (the space between 88 or 94 in figures 4 and 5. (claim 64) Zirkiev discloses a device with the blade section elevated to a cutting height, which is the same as the prescribed height. (figure 2, claim 34-35, 65-66) Zirkiev discloses the claimed device having a blade section with a row of teeth (Figure 4 and 5) and with at least one predetermined cutting angle (claims 67-68). Zirkiev discloses the claimed invention where substrate can be sliced along the grain of the substrate (claim 77).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 69-74 and 111/47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zirkiev (US Pat 5745999).

Zirkiev discloses the claimed invention except for disclosing the cutting angle of the tooth and the substrate is bone. In regards to the cutting angles (claims 38-43 and 69-74), it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the tooth of the device with different angles, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In regards to the substrate being bone, it would have been

obvious to one having ordinary skill in the art at the time the invention was made to have the substrate be bone, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Allowable Subject Matter

Claims 50-63 and 78-86 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 33-46, 94-110, 111/94, 111/95, 111/96 and 111/97 are allowed.

Response to Arguments

Applicant's arguments filed 09/28/2006 have been fully considered but they are not persuasive. Applicant has argued that Zirkiev '999 does not teach cutting devices that involved moving a cutter relative to a fixed substrate. The Examiner argues that this limitation amounts to intended use.

With regard the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Zirkiev '999 which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

If a first element (a substrate) is movable relative to a second (a cutter), then, the second is also movable relative to the first. The device of Zirkiev is capable of operating upside down with the substrate in a fixed position and the cutter moving relative thereto.

If a first element (a substrate) is movable relative to a second (a cutter), then, the second is also movable relative to the first. The device of Zirkiev is capable of operating upside down with the substrate in a fixed position and the cutter moving relative thereto.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is 571-272-2243. The examiner can normally be reached on M-F.

Art Unit: 3733

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael B. Priddy
Michael B. Priddy
September 16, 2007


EDUARDO O. ROBERT
SUPERVISORY PATENT EXAMINER